APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,273	09/24/2003	Richard Cudd	00169.002486	3494

5514   7590   06/19/2008
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
DULANEY, BENJAMIN O

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
06/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 September 2003</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.
      4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-15</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
      Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
      Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
      a)☒ All   b)☐ Some * c)☐ None of:
         1.☒ Certified copies of the priority documents have been received.
         2.☐ Certified copies of the priority documents have been received in Application No. _____.
         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
              application from the International Bureau (PCT Rule 17.2(a)).
      * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
      Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

1)   Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

2)   Regarding claim 10, the claim states "performing the method of any one of claims

1 to 9" at the end of the claim. Proper formatting of a multiple dependent claim should

begin with a statement such as "A method according to any one of claims 1 to 9".

Appropriate correction is required.

3)   Claim 11 is rejected because it depends from claim 10.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

> The USPTO "Interim Guidelines for Examination of Patent Applications for Patent
> Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex
> IV, reads as follows:

> Descriptive material can be characterized as either "functional descriptive material" or
> "nonfunctional descriptive material." In this context, "functional descriptive material" consists of
> data structures and computer programs which impart functionality when employed as a computer
> component. (The definition of "data structure" is "a physical or logical relationship among data
> elements, designed to support specific data manipulation functions." The New IEEE Standard
> Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Non functional descriptive

material" includes but is not limited to music, literary works and a compilation or mere
arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes
structurally and functionally interrelated to the medium and will be statutory in most cases since
use of technology permits the function of the descriptive material to be realized. Compare In re
Lowry, 32 F.3d 1579, 1583-84, 32USPQ2d1031, 1035 (Fed Cir. 1994) (claim to data structure
stored on a computer readable medium that increases computer efficiency held statutory) and
Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data
structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at
1361, 31 USPQ2d at 17660 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a
computer element which defines structural and functional interrelationships between the
computer program and the rest of the computer which permit the computer program's
functionality to be realized, and is thus statutory See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at
1035.

Claims 12 and 13 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter as follows. Claims 12 and 13 define

a computer program embodying functional descriptive material. However, the claim

does not define a computer-readable medium or memory and is thus non-statutory for

that reason (i.e. "When functional descriptive material is recorded on some computer-

readable medium it becomes structurally and functionally interrelated to the medium

and will be statutory in most cases since use of technology permits the function of the

descriptive material to be realized" -Guidleines Annex IV). That is the scope of the

presently claimed computer program can range from paper on which the program is

written, to a program simply contemplated and memorized by a person. Appropriate

correction is required. Any amendment to the claim should commensurate with its

corresponding disclosure.

Claim 15 is rejected because the means plus function language parallels claim

12 which, as previously stated, refers to a program as the "means" for execution of the

claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4)   Claims 1-3, 5-9 and 12-15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. patent application publication 2004/0201613 by Simpson et al.,

and further in view of U.S. patent 6,978,445 by Laane.

5)   Regarding claims 1, 12, 14 and 15, Simpson teaches a method of forming a

printable representation of a document having framed content, said method comprising

the steps of: (a) recording the position, height and width of each frame of said document

in a display widow in which said document is presented (paragraph 59; in order to place

frames on the display in a specific location, it is inherent that the position and size of the

object are recorded), (b) identifying dimensions of a printing medium associated with

said printable representation (figure 7, item 290); (c) determining a height of content of

each said frame (paragraph 59); (e) interpreting the records to establish a display order

of said frames (paragraph 61); (f) for each said frame, and in said display order: (fb)

creating a display region upon a page in said printable representation at said start

position according to said corresponding content height (figure 6); (fc) placing the

content of said frame into said display region (paragraph 59); and (fd) where said

display region exceeds a page limit in said printable representation, terminating the

display region at the page limit and creating a further display region upon a following

page of the printable representation (paragraph 53; figure 8).

Simpson does not specifically teach (d) determining, for each said frame, a

record of any corresponding dependency frames, each said dependency frame being

above said frame in said display window; (fa) checking a start position of said frame

against an end position of a created display region of a frame upon which said frame is

dependent, and setting said start position to be said end position.

Laane teaches (d) determining, for each said frame, a record of any

corresponding dependency frames, each said dependency frame being above said

frame in said display window (column 5, lines 38-41); (fa) checking a start position of

said frame against an end position of a created display region of a frame upon which

said frame is dependent, and setting said start position to be said end position (figure 3,

items 310a and 310b).

Simpson and Laane are combinable because they are both from the internet

display field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine Simpson with Laane to add frame dependency. The

motivation for doing so would have been to correctly display a loaded page (column 5,

lines 38-41). Therefore it would have been obvious to combine Simpson and Laane to obtain the invention as specified by claims 1, 12, 14 and 15.

6)   Regarding claim 2, Simpson teaches a method according to claim 1 wherein step (c) comprises: (ca) determining a width of said content of each said frame; (cb) determining a scaling factor by which the content width of said frame need be adjusted to correspond to a corresponding display width of said frame in said display window; and step (fb) further comprises scaling the content of said frame according to said scaling factor to fit within said display width (paragraph 51).

7)   Regarding claim 3, Simpson teaches a method according to claim 2 wherein step (fb) comprises: (i) applying a zoom to the display region corresponding to the scaling factor; and (ii) expanding a width of the display region by the inverse of the scaling factor to thereby reveal content otherwise obscured (paragraph 59).

8)   Regarding claim 5, Simpson does not specifically teach A method according to claim 1 wherein step (d) comprises forming a linear array of records incorporating links from records of dependent ones of said frames to frames from which they depend.

        Laane teaches a method according to claim 1 wherein step (d) comprises forming a linear array of records incorporating links from records of dependent ones of said frames to frames from which they depend (column 5, lines 6-8; a script would execute linearly and an array is a very well known in the art data structure that would be obvious to use).

        Simpson and Laane are combinable because they are both from the internet display field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Simpson with Laane to add frame dependency. The motivation for doing so would have been to correctly display a loaded page (column 5, lines 38-41). Therefore it would have been obvious to combine Simpson and Laane to obtain the invention as specified by claim 5.

9)   Regarding claim 6, Simpson teaches a method according to claim 1 wherein no account is taken of horizontal dependency between said frames (Simpson does not teach anything dealing with horizontal dependency and therefore teaches that no account of it is taken).

10)   Regarding claim 7, Simpson teaches a method according to claim 1 wherein said printable representation is a print preview representation (figure 4).

11)   Regarding claim 8, Simpson teaches a method according to claim 1 wherein said printable representation comprises at least part of a print job dispatched to a printer (paragraph 22).

12)   Regarding claim 9, Simpson teaches a method according to claim 1 wherein said document comprises an HTML document defining a Web page (paragraph 24, 25, 38 and 39).

13)   Regarding claim 13, Simpson teaches a computer program according to claim 12 wherein said program forms a sub-application associated with a browser application and having a graphical user interface formed with a graphical user interface of said browser application (paragraph 30).

14)   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

patent application publication 2004/0201613 by Simpson et al., and further in view of

U.S. patent 6,978,445 by Laane, and further in view of U.S. patent application

publication 2002/0046238 by Estavillo et al.

Simpson does not specifically teach a method according to claim 1 wherein step

(b) comprises reducing said dimensions by margin dimensions to be formed in said

printable representation.

Estavillo teaches a method according to claim 1 wherein step (b) comprises

reducing said dimensions by margin dimensions to be formed in said printable

representation (paragraph 49; figure 8).

Simpson and Estavillo are combinable because they are both from the print

preview field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine Simpson with Estavillo to add margin dimensions. The

motivation for doing so would have been to "show an accurate preview" (paragraph 49).

Therefore it would have been obvious to combine Simpson and Estavillo to obtain the

invention as specified by claim 4.

15)   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

patent application publication 2004/0201613 by Simpson et al., and further in view of

U.S. patent 6,978,445 by Laane, and further in view of U.S. patent application

publication 2002/0143814 by Hepworth et al.

Simpson (in view of Laane) teaches performing the method of any one of claims 1 to 9

Simpson does not specifically teach a method of forming a printable representation of a Web page, said method comprising: (i) detecting one of a print or a print preview selection for said Web page from a Web browser application; (ii) examining a definition of said Web page for the presence of frames; and (iii) where step (ii) detects the presence of at least one frame in said Web page.

Hepworth teaches a method of forming a printable representation of a Web page, said method comprising: (i) detecting one of a print or a print preview selection for said Web page from a Web browser application (paragraph 57); (ii) examining a definition of said Web page for the presence of frames; and (iii) where step (ii) detects the presence of at least one frame in said Web page (paragraph 55, 56 and 44).

Simpson and Hepworth are combinable because they are both from the internet display.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Simpson with Hepworth to add frame detection. The motivation for doing so would have been for "enhancing a material with machine readable graphical codes" (abstract). Therefore it would have been obvious to combine Simpson and Hepworth to obtain the invention as specified by claim 10.

16)   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent application publication 2004/0201613 by Simpson et al., and further in view of

U.S. patent 6,978,445 by Laane, and further in view of U.S. patent application

publication 2002/0143814 by Hepworth et al., and further in view of U.S. patent

7,047,033 by Wyler.

   Simpson does not specifically teach a method according to claim 10, further

comprising the step of: (iv) where step (ii) fails to detect the presence of a frame,

forming the printable representation according to the browser application.

   Wyler teaches a method according to claim 10, further comprising the step of: (iv)

where step (ii) fails to detect the presence of a frame, forming the printable

representation according to the browser application (column 35, lines 3-15; when

frames are detected a special browser is used, when not detected a different browser is

used, therefore the limitation is satisfied).

   Simpson and Wyler are combinable because they are both from the internet

display.

   It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine Simpson with Wyler to add forming a printable

representation according to the browser. The motivation for doing so would have been

"to determine whether ... special features were supported" (column 35, lines 5-7).

Therefore it would have been obvious to combine Simpson and Wyler to obtain the

invention as specified by claim 11.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN O. DULANEY whose telephone number is (571)272-2874. The examiner can normally be reached on Monday - Friday (10am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/

Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625